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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,592	07/31/2001	Brian Bodmer	LS/0023.00	5999
7590 08/15/2007 JUDITH A. SZEPESE BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025			EXAMINER SHAH, AMEE A	
			ART UNIT 3625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/920,592

Applicant(s)

BODMER ET AL.

Examiner

Amee A. Shah

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 58-61, 64-67 and 73-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 58-61, 64-67 and 73-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-19, 58-61, 74-67 and 73-39 are pending in this action.

Response to Amendment

Applicant's amendment, filed June 7, 2007, has been entered. Claims 1, 58, 67 and 73-79 have been amended. In view of the amendments, the 35 U.S.C. §112 regarding the third party and the §101 rejections are withdrawn. However, the amendments present new 35 U.S.C. §112 rejections.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the e-commerce retailer" in line 6 of the claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of this action, the Examiner will interpret the limitation to be any e-commerce retailer. Because claims 2-19 are dependencies of claim 1, they inherit the same deficiencies, are rejected on the same bases, and are interpreted in the same manner.

Examiner Note

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. §103(a).

Claims 1-9, 16, 58-61, 67 and 76-79 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tam et al. 2002/0184116 A1 (hereafter referred to as “Tam ’116) in view of Tam et al., US 2002/0147656 A1 (hereafter referred to as “Tam 656”).

Referring to claim 1.

The prior art Tam ’116 teaches a method for an e-commerce retailer to display and sell items of a third party (e.g. Fig. 1) comprising: identifying each item of a third party supplier with a unique identifier (Figs. 5F and 8 and ¶¶0035 and 0036 – note the identifier can be the stock or UPC number, the retailer is the aggregator and the third party supplier is the seller); associating the unique identifier of the item with an image of the item, said image residing on a computer maintained by the third party supplier (Fig. 5F and ¶0035 – note that the seller selects an image file that can reside on “my computer,” i.e. the seller’s computer); and presenting at least some of the images of third party supplier items to the user for on-line commerce, (Fig. 8 and ¶0078-0079 – note the user is the buyer), with the seller maintaining the images on the seller computer (Fig. 5F). Tam ’116 also teaches a structure of holding product information for the purpose of selling (see, e.g., Fig. 2)

The related application of the prior art Tam ’656 teaches a system and method for e-commerce using a catalog wherein the images of the third party supplier items are presented by an e-commerce retailer in response to a product request from a user to the e-commerce retailer (¶¶0071 and 0076 – note the request is the registration information and the buying habits and the e-commerce retailer is the aggregator), the product information residing in the seller’s computer is retrieved by the aggregator (¶¶0021, 0025 and 0026 – note that the aggregator maintains a

Art Unit: 3625

database of pointers product information maintained in the seller's databases and retrieves such information based on these pointers), and in response to an order request from the user to the e-commerce retailer for one or more items, identifying, based at least in part on said unique identifier, each item requested and an appropriate third party supplier for each requested item and automatically generating an order for each requested item to be transparently sent to the third party supplier (§§0037, 0038 and 0047 – note that the buyer selects to purchase one or more of the items from the aggregator catalog, i.e. an order request from the user, the products are identified by their related product numbers and, in order for the order send to the appropriate seller or fulfiller, the appropriate seller is inherently identified).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method and system of Tam '116 to include the teachings of Tam '656 to allow for the images to be retrieved from the seller's computer, to identify each item requested based in part on the identifier in response to an order request, and to identify and generate an order for each item to be sent to the appropriate third party seller. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by and envisioned by Tam '656 in order to have a complete selling system with a complete catalog to facilitate the sale and delivery of goods and services (§§0006 and 0026).

Referring to claims 2 and 3. The prior arts Tams further teach the method of claim 1 wherein the items include products and services (Tam '116, §0018 teaches products and services such as downloading and Tam '656, §0019 discusses how it is old in the art for retailers to sell products and services).

Referring to claim 4. The prior arts Tams further teach the method of claim 1 wherein the images of items include graphic images (Tam '116, Fig. 8).

Referring to claim 5. The prior arts Tams teach the method of claim 1 wherein the images of items include descriptive text (Tam '116, Fig. 8).

Referring to claim 6. The prior arts Tams teach the method of claim 1 wherein a given unique identifier references a corresponding product Stock Keeping Unit (SKU) numbers (Tams '116, Figs. 5F and 8 and ¶¶0035 and 0036 – note the identifier can be the stock number).

Referring to claim 7. The prior arts Tams further teach the method of claim 1 wherein a given unique identifier references pricing information from a third party (Tams '116, Fig. 5G and ¶¶0037 and 0070 discuss the third party including pricing information in the product description and referencing the information from the database and Tams '656, ¶¶0025 and 0084 teach referencing that information through the use of pointers).

Referring to claim 8. The prior art Tams further teach the method of claim 1 wherein a given unique identifier references order fulfillment information (Tam '656, ¶0078 – note that the unique identifier is the transaction identifier and the order fulfillment information includes the seller, fulfiller (if any), and product information). One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in

Art Unit: 3625

the art at the time of the invention that doing so would provide for a record of the transactions to be used in the future for such purposes as marketing or auditing.

Referring to claim 9. The prior arts Tams teach the method of claim 1, as discussed above, wherein said step of presenting includes: requesting images from a third party (Tam '116, Fig. 5F and ¶0035 – note that the request is performed by the request for information submitted through the dialog boxes); receiving a list of Uniform Resource Locators (URLs) for said requested images (Tam '656, ¶¶0021, 0025 and 0125 – note the database contains a list of pointers to product information, including images, received from the sellers and that the pointers can be URLs); and displaying an on-line page that displays images retrieved from said URLs (Tam '116, Fig. 8).

Referring to claim 16. The prior arts Tams further teach the method of claim 1 wherein the images are rendered on a Web page for display to the user (Tams '116, Fig. 8).

Referring to claims 58-61, 67 and 76-79. All of the limitations in apparatus claims 58-61, 67 and 76-79 are closely parallel to the limitations of method claims 1-4, analyzed above and are rejected on the same bases.

Claims 10-12, 17, 64 and 75 are rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams in view of Baum, US 2002/0065741 A1 (hereinafter referred to as “Baum”).

Referring to claim 10. The prior art Tams teach the method of claim 9, as discussed above, but do not teach wherein the request for images includes background and formatting information of a particular third party. Baum, in the same field of endeavor and/or pertaining to the same issue, teaches a method for distributing images to multiple recipients including wherein requests for images from a third party to be presented to a user include background and formatting information of a particular third party (¶¶0072 and 0075 – note that the products/services are photofinishing services/prints of photographic images and that the images of the product are the photographic images).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams to include the teachings of Baum to allow for the request for images includes background and formatting information of a particular third party. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Baum that doing so would allow users to be able to consider alterations to the products/images that may better suit their purposes (¶0072).

Referring to claim 11. The prior art Tams teach the method of claim 1, as discussed above, but do not specifically teach wherein a particular third party provides photo-finishing services and the images correspond to user photographic images. Baum, in the same field of endeavor and/or pertaining to the same issue, teaches a method for distributing images to multiple recipients including wherein a particular third party provides photo-finishing services and the images correspond to user photographic images (*see, e.g.*, ¶0011). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the

Art Unit: 3625

method of the prior arts Tams to include the teachings of Baum to allow for a particular third party to provide photo-finishing services and the images to correspond to user photographic images. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Baum that doing so would allow users to be able to order image prints in a manner that minimizes the user's time, effort and expense (§0012).

Referring to claim 12. The prior arts Tams teach the method of claim 1 wherein a given third party provides URLs for images, as discussed above, but do not specifically teach wherein URLs are provided for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats. Baum, in the same field of endeavor of e-shopping, teaches a method for distributing images to multiple recipients including wherein a given third party provides URLs for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats (Figs. 5 and 9, and §0080).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams to include the teachings of Baum to allow for a given third party to provide URLs for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Baum that doing so would allow users to have access to view images in various manners to better determine which image to order (§0072 and 0075).

Art Unit: 3625

Referring to claim 17. The prior arts Tams teach the method of claim 1, as discussed above, but do not teach wherein the unique identifier of an item requested by the user is employed for placing a fulfillment request with a corresponding third party. Baum, in the same field of endeavor of e-shopping, teaches a method for distributing images to multiple recipients including wherein the unique identifier of an item requested by the user is employed for placing a fulfillment request with a corresponding third party (§0075 – note the unique identifier is the number used to reorder).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior art Tams to include the teachings of Baum to allow for the unique identifier of an item requested by the user to be employed for placing a fulfillment request with a corresponding third party. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Baum that doing so would provide for a more seamless and accurate ordering system (§0075).

Referring to claims 64 and 75. All of the limitations in apparatus claims 64 and 75 are closely parallel to the limitations of method claim 17, analyzed above, and are rejected on the same bases.

Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams in view of Garfinkle et al. US 6,017,157 (hereinafter referred to as “Garfinkle”).

Referring to claim 13. The prior arts Tams teach the method of claim 1 but do not specifically teach wherein a given third party initially provides smaller thumbnail images of the

Art Unit: 3625

items and provides larger images in response to user requests. Garfinkle, in the same field of endeavor and/or pertaining to the same issue, teaches a method of processing and distributing digital images wherein a party initially provides smaller thumbnail images of the items and provides larger images in response to user requests (col. 7, lines 4-15).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior art Tams to include the teachings of Garfinkle to allow for a given third party to initially provide smaller thumbnail images of the items and to provide larger images in response to user requests. One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so allow for suppliers to provide more details at once on a single page by showing a small depiction of a product with larger depictions available upon request, thereby saving valuable advertising space, and for users to get a more accurate depiction of a product by enlarging on a small depiction.

Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams in view of Lyons et al., US 2002/0077937 A1 (hereinafter referred to as “Lyons”).

Referring to claim 14. The prior arts Tams teach the method of claim 1, as discussed above, but do not teach wherein a given third party evaluates the request for images or descriptions and automatically indicates whether corresponding items are available. Lyons, in the same field of endeavor and/or pertaining to the same issue, teaches a method for ensuring availability of inventory for electronic commerce, including wherein a given third party

evaluates the request for images or descriptions and automatically indicates whether corresponding items are available (§§0045-0046).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior art Tams to include the teachings of Lyons to allow for a given third party to evaluate the request for images or descriptions and automatically indicate whether corresponding items are available. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Lyons that doing so would provide buyers with confirmation that the desired items are actually available and aid them in the purchase decision (§0005).

Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams in view of Shmueli et al., US 2002/0143637 A1 (hereinafter referred to as “Shmueli”).

Referring to claim 15. The prior arts Tams teach the method of claim 1, as discussed above, but do not teach wherein the unique identifier associated with a given item is stored in a user's shopping cart when the user selects the item. Shmueli, in the same field of endeavor and/or pertaining to the same issue, teaches a portable shopping cart wherein the unique identifier associated with a given item is stored in a user's shopping cart when the user selects the item (§0066).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams to include the teachings of Shmueli to allow for the unique identifier associated with a given item to be stored in a user's shopping cart

Art Unit: 3625

when the user selects the item. One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would provide for a more seamless and efficient transaction in ensuring that the item desired can be held in a virtual shopping cart before the buyer must make a final determination whether or not to buy the item.

Claims 18, 19, 65, 66, 73 and 74 are rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams in view of Johnson et al., US 6,505,172 B1 (hereinafter referred to as “Johnson”).

Referring to claims 18-19. The prior arts Tams teach the method of claim 1, as discussed above, but do not teach the method further comprising automatically splitting an order including individual order items from more than one third party, and assigning fulfillment of individual order items to the appropriate third parties (claim 18), nor splitting order including items from the retailer and items from one or more third parties amongst the retailer and the appropriate third parties (claim 19). Johnson, in the same field of endeavor and/or pertaining to the same issue, teaches a method for electronic sourcing of items including automatically splitting an order including individual order items from more than one third party, and assigning fulfillment of individual order items to the appropriate third parties, and splitting an order including items from the retailer and items from one or more third parties amongst the retailer and the appropriate third parties (col. 15, line 39 through col. 16, line 15).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams to include the teachings of Johnson to

allow for automatically splitting an order including individual order items from more than one third party, and assigning fulfillment of individual order items to the appropriate third parties, and splitting an order including items from the retailer and items from one or more third parties amongst the retailer and the appropriate third parties. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Johnson that doing so would allow buyers to purchase from multiple vendors at one session (col. 2, lines 8-22).

Referring to claims 65, 66, 73 and 74. All of the limitations in apparatus claims 65, 66, 73 and 74 are closely parallel to the limitations of method claims 18 and 19, analyzed above, and are rejected on the same bases.

Response to Arguments

Applicant's arguments filed June 7, 2007, have been fully considered but they are not persuasive. In response to applicant's argument that neither Tams teaches or suggests identifying each item of a third party supplier with a unique identifier because each item is not the same as each product and a UPC or stock number identifies only a product as opposed to an item (Remarks, pages 12-13), the Examiner disagrees. First, a UPC uniquely identifies a product and manufacturer (see Glossary obtained from www.ablt.com) and a stock number uniquely identifies each item stocked in a retailer's warehouse (see Glossary obtained from www.washington.edu). Therefore, the prior art Tams teaches identifying each item with a unique identifier such as a stock number as discussed above. Second, applicant's claims contradict applicant's argument in that claims 2 and 3 define "item" as either products or

Art Unit: 3625

services and claim 6 defines “unique identifier” as a SKU number, which can be represented by a UPC (see Common Terms and Definitions of www.vendorcompliance.info). Therefore, the item of claim 1 can be a product and a UPC can be a unique identifier.

In response to applicant’s argument that the prior art does not teach or suggest the limitation of presenting at least some of the images in response to a product request because Tams described obtaining images prior to any information request of a buyer (Remarks, pages 12-14), the Examiner disagrees. Tam ‘656, as discussed above, teaches the aggregator creating a catalog based on user registration and user purchases, creating a user history, i.e. a user product request.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3625


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ameer A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

August 10, 2007


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